

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

#### ***Status of the Claims***

Claims 1-6, 8-12, and 18-20 are pending, of which Claims 1-7 and 18-20 are active; Claims 1 and 4-6 are amended; Claims 18-20 are newly added; and Claims 7 and 13-17 are canceled herewith. It is respectfully submitted that no new matter is added by this amendment.

#### ***Summary of the Office Action***

In the outstanding Office Action, the Information Disclosure Statements filed October 1, 2003 and September 23, 2004 were objected to; the disclosure was objected to; the specification was objected to as failing to provide proper antecedent basis for the subject matter claimed; Claims 1-7 and 13-17 were rejected under 35 U.S.C. § 112, second paragraph; Claims 13-17 were rejected under 35 U.S.C. § 102(b) as anticipated by Terazawa, U.S. Patent Publication No. 2001/0041083; Claims 1-6 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Totsuka (U.S. Pat. No. 5,380,614); Claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over Totsuka in view of Baba (U.S. Pat. No. 5,340,677); Claims 1-6 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Japanese Patent No. 03-116054 (hereafter JP '054), as evidenced by Totsuka; Claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over JP '054, as evidenced by Totsuka, combined with Baba;<sup>1</sup> Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Terazawa in view of Totsuka; and Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Terazawa in view of JP '054.

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<sup>1</sup> Applicants note that although the Office Action refers to JP '059, JP '059 was not cited in the outstanding Office Action. Accordingly, Applicants address the rejection with respect to JP '054.

***Objection to the Information Disclosure Statements***

The outstanding objection to the Information Disclosure Statements was addressed by remarks previously filed by the Applicants on October 15, 2005. Accordingly, it is respectfully submitted that this objection has been obviated.

***Objection to the Disclosure***

With regard to the objection to the disclosure, the informality noted in the outstanding Office Action has been amended herewith. Namely, the specification has been amended to include the proper format for the HENSCHHEL trademark. Accordingly, it is respectfully requested that the objection to the disclosure be withdrawn.

***Objection to the Specification***

With regard to the objection to the specification as failing to provide proper antecedent basis for the claimed subject matter, this objection is respectfully traversed. The outstanding Office Action alleges at page 5 that there is no antecedent basis in the specification for “the replenished toner composition and the previously existing toner composition reach at least one of the doctor blade and the doctor roller.”<sup>2</sup> The outstanding Office Action further alleges at page 6 that the specification only discloses that the toner composition reaches the regulating member.

However, Applicants note that the regulating member is described as including a doctor blade and doctor rollers configured to regulate flow of the toner to the developing sleeve.<sup>3</sup> Accordingly, it is respectfully submitted that the specification provides antecedent basis for the claimed subject matter, and it is requested that the outstanding objection be withdrawn.

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<sup>2</sup> This feature is now recited in Claims 18-20.

<sup>3</sup> Specification, page 9, lines 16-18.

***Rejection Under 35 U.S.C. § 112, Second Paragraph***

With regard to the rejection of Claims 1-7 and 13-17 under 35 U.S.C. § 112, second paragraph, that rejection is respectfully traversed. The informalities noted in the outstanding Office Action have been addressed by this amendment.<sup>4</sup> Accordingly, it is respectfully requested that this rejection be withdrawn.

***Rejection of Claims 13-17 Under 35 U.S.C. § 102 Over Terazawa***

Turning to the outstanding rejection of Claims 13-17 under 35 U.S.C. § 102 as anticipated by Terazawa, that rejection has been obviated by the cancellation of Claims 13-17.

***Rejection of Claims 1-6 Under 35 U.S.C. § 102 Over Totsuka***

Claims 1 and 6 have been amended to include subject matter analogous to the subject matter previously recited in Claim 7. Accordingly, it is respectfully submitted that this rejection has been obviated by the present amendment, and the rejection of Claim 7 will be addressed below.

***Rejection of Claim 7 Under 35 U.S.C. § 103 Over Totsuka in View of Baba***

The outstanding rejection of Claim 7 under 35 U.S.C. § 103(a) as unpatentable over Totsuka in view of Baba is respectfully traversed. Independent Claims 1 and 6 have been amended to include the features of Claim 7.

The outstanding Office Action admits at page 14 that Totsuka does not disclose or suggest the claimed carrier. The outstanding Office Action attempts to remedy this admitted deficiency by relying upon the teachings of Baba.

In more detail, although the outstanding Office Action admits that Baba does not disclose the claimed carrier, the Office Action states at pages 15-16 that “it is reasonable to presume that the resin coating on the magnetic core particles in the Baba carrier in example 1

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<sup>4</sup> Claims 13-17 have been cancelled herewith, thereby obviating their rejection.

meets the thickness limitation recited in instant claim 7.” The outstanding Office Action then attempts to shift the burden to the Applicants to prove otherwise.

However, as set forth in MPEP § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

Moreover, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a certain set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Finally, “In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. (1990)) (emphasis in original).

It is respectfully submitted that the outstanding Office Action has not satisfied the requirements set forth in MPEP § 2112, in that the outstanding Office Action has not shown that the allegedly inherent characteristic necessarily flows from the teachings of the applied references, which violates the requirements set forth in *Ex Parte Levy*. In more detail, the Office Action argues that because “Baba discloses that the carrier core particles in example 1 are ‘uniformly coated’ with the resin coating confirmed by SEM,” the claimed carrier coating is inherent in the teachings of Baba.

However, there is no disclosure or suggestion in Baba of the claimed thickness in a range of from 75% to 125% of an average thickness thereof. Certainly, the outstanding Office Action has not cited to any teachings in Baba that support the assertion that the claimed thickness is inherent. As a result, it is respectfully submitted that the outstanding

Office Action has failed to provide a *prima facie* case of obviousness for the features of original Claim 7.

Accordingly, because features analogous to those set forth in original Claim 7 are now recited in independent Claims 1 and 6, it is respectfully submitted that Claims 1-6 and 18-20 patentably distinguish over the applied combination of Totsuka and Baba.

***Rejection of Claims 1-6 Under 35 U.S.C. §§ 102/103 Over JP '054 in View of Totsuka***

With regard to the outstanding rejection of Claims 1-6 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP '054 as evidenced by Totsuka, that rejection is also respectfully traversed.

Because Claims 1 and 6 have been amended to include features analogous to those of cancelled Claim 7, it is respectfully submitted that this rejection is obviated by the present amendment.

***Rejection of Claim 7 Under 35 U.S.C. § 102 Over JP '054 in View of Totsuka and Baba***

With respect to the rejection of Claim 7 under 35 U.S.C. § 103(a) as unpatentable over JP '054 as evidenced by Totsuka combined with Baba, that rejection is also respectfully traversed.

The outstanding Office Action admits at page 20 that JP '054 does not disclose or suggest the claimed carrier. Nonetheless, the outstanding Office Action asserts that Baba remedies the admitted deficiencies of JP '054, and incorporates by reference the arguments set forth for Baba with respect to the rejection of Claim 7 as unpatentable over Totsuka when combined with Baba.

As noted above, the outstanding Office Action has not satisfied the requirements of MPEP § 2112 to show that the claimed features are inherent within the teachings of Baba, as alleged in the Office Action. As a result, the Office Action has again failed to provide a *prima facie* case of obviousness with respect to the subject matter recited in original Claim 7.

Accordingly, as the outstanding Office Action has failed to provide a *prima facie* case of obviousness with respect to Claim 7, it is respectfully submitted that Claims 1-6 and 18-20 patentably distinguish over JP '054 as evidenced by Totsuka combined with Baba.

***Remaining Rejections of Claims 16 and 17***

Additionally, it is respectfully submitted that the remaining rejections of Claims 16 and 17 have been obviated by this amendment, as these claims have been canceled herewith.

***Support for New Claims 18-20***

Newly added Claims 18-20 recited features previously disclosed in the specification, for example, at page 9. Accordingly, it is respectfully submitted that no new matter is added by Claims 18-20, and Claims 18-20 are believed to distinguish over the applied references for at least the reasons above set forth with regard to Claims 1 and 6.

***Conclusion***

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

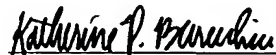
Respectfully submitted,

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